

Rejections under 35 USC §112

The Examiner rejected claims 1, 3, 13, 21, and 29-68 under 35 USC §112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention, and cited the Interim Guidelines. The Examiner alleged that the application did not provide a sufficient number of representative species, stating that only one species was identified for each molecule. Applicant respectfully traverses this rejection.

The Examiner's statements concerning the present disclosure do not properly reflect the information provided. In particular, the present Seq. ID Nos. each uniquely correspond to a particular gene, as the identification method provides unique mRNA identification. Therefore, the present disclosure and claims properly demonstrate that Applicant was in possession of the claimed invention. Further, the Examiner's assertion that a representative number of species was not disclosed again does not properly reflect the information provided to one skilled in the art. In particular, one skilled in the art will recognize that a large number of additional shorter species of sequences are inherent in the provision of the particular sequences.

In addition, one skilled in the art is fully enabled to obtain any of the longer species using a provided sequence by routine methods, e.g., by probing a cDNA library, or other methods as described in the present specification.

Therefore, Applicant has fully satisfied the Written Description requirement, by providing uniquely identifying characteristics, and because one skilled in the art would recognize that the sequences provided inherently describe many shorter sequence species, and one skilled in the art would have no difficulty in obtaining others.

The Examiner also rejected claims 1, 3, 13, 21, and 29-68 under 35 USC §112, first paragraph, as the specification is allegedly enabling only for claims limited to polynucleotides consisting of the elected sequences or fragments thereof. The Examiner stated that the claims are intended to encompass a variety of species including full-length cDNAs, genes, and protein coding regions, and asserted that the specification fails to provide an enabling disclosure for one skilled in the art to obtain full length cDNAs or genomic sequences, and further does not describe how to use the sequences. Applicant respectfully traverses this rejection.

Preliminarily, Applicant notes that the disclosure provides multiple uses for the claimed sequences, including as probes, primers, and for providing unique sequences for identifying tissue expression status and patterns for the corresponding genes, (see, e.g., p. 1, Fields of the Invention) including identifying and obtaining tissue specific genes (see, e.g., p.17, last paragraph) (see also, p.18, second paragraph). Applicant also notes that a large amount of expression information is provided in the Tables. Similar expression information can be readily obtained for the particular genes for any tissue and for disease states of interest.

Further, one skilled in the art can readily obtain longer sequences. Such methods are routine in the art, and examples are described on pages 20-26, and in Example 10. Thus, contrary to the Examiner's assertion, one skilled in the art would be able to obtain additional species without undue experimentation, and the full scope of the claims is properly enabled.


In view of the discussion above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections under 35 USC §112, first paragraph.

Applicant submits that the pending claims are in condition for allowance and respectfully requests a notice to that effect.

Applicant hereby requests a three month extension of time to respond to the outstanding Office Action. Kindly charge the fee for that extension to Deposit Account 12-2475. If any additional fee is due, kindly charge the appropriate amount to Deposit Account No. 12-2475.

Respectfully submitted,

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